

an anti-bleedout resin (B) comprising a polyphenylene ether-based resin, a polystyrene-based resin or mixture thereof, the anti-bleedout resin being present in an amount of 10 to 500% by weight based on the weight of said phosphazene compound (C),

resin pellets comprising said flame retardant resin composition being producible by extruding of said flame retardant resin composition by using a twin-screw extruder at 270 °C without bleed-out of phosphazene compound (C).

REMARKS

This invention relates to a flame retardant resin composition which has excellent flame retardant properties, mechanical properties, and heat resistance. Further, by selecting the correct combination of resins, this invention avoids the problem of bleed-out of flame retarder.

Nakacho states: p-10, lines 7-18

A wide variety of resins known in the art may be used as the thermoplastic resin for use in the present invention. Such resins are, for example, polyethylene, polypropylene, polyisoprene, polyesters (polyethylene terephthalate, polybutylene terephthalate, etc.) polybutadiene, styrene resin, impact-resistant polystyrene, acrylonitrile-styrene resin (AS resin), acrylonitrile-butadiene-styrene resin (ABS resin), methyl methacrylate-butadiene-styrene resin (MBS resin), methyl methacrylate-acrylonitrile-butadiene-styrene resin (MABS resin), acrylonitrile-acrylic rubber-styrene resin (AAS resin), polymethyl (meth)acrylate, polycarbonate, modified polyphenylene ether (PPE), polyamide, polyphenylene sulfide, polyimide, polyether ether ketone, polysulfone, polyarylate, polyether ketone, polyether nitrile, polythioether sulfone, polyether sulfone, polybenzimidazol,

polycarbodiimide, polyamideimide, polyetherimide, liquid crystalline polymer, composite plastics and the like.

Among these thermoplastic resins, polyester, ABS resin, polycarbonate, modified polyphenylene ether, polyamide, etc., are preferably used.

In the present invention, the thermolastic resins may be used singly or in combination. Nakacho (EP 0945478) paragraphs [0075], [0076], [0077].

In the Nakacho reference, there are 31 different types of resins mentioned as the possible resin.

Thus, there is no disclosure in Nakacho of the selection of the specific combination of polyamide and polyphenylene ether-based resin and/or a polystyrene based resin, out of all of the possibilities presented in the disclosure. Furthermore, there is no motivation or suggestion contained within the disclosure of Nakacho, or cited by the examiner, that would lead one skilled in the art to choose the particular combination of resins of this invention out of the many possibilities presented in Nakacho.

Nakacho does not even remotely mention the possibility that particular selections of resins can avoid problems of bleedout of flame retardants. Rather, in Nakacho the polyester, ABS resin, polycarbonate, modified polyphenylene ether, polyamide, etc., are preferably used singly or in combination. So, when using the polyamide resin there is no motivation presented for choosing the combination of a polyamide and polyphenylene ether-based resin and/or a polystyrene-based resin. One of ordinary skill in the art having no knowledge of this invention, would have no motivation for choosing the particular combinations here presented.

This use of hindsight violates well established Federal Circuit, and its predecessor court, the Court of Customs and Patent Appeals (CCPA), case law. It is well established that when there is only a broad generic disclosure encompassing many species, there must be some motivation or guidance to one skilled in the art to the selection a particular species in order for that species to be considered disclosed.

In the case of *In re Ruschig* the CCPA was presented with the question of whether a specific compound of claim 13, chlorpropamide, that was within a broad generic disclosure that encompassed many compounds, but that was not specifically named or mentioned in the disclosure, was disclosed as being invented by the applicants. *In re Ruschig*, 154 USPQ 118 (CCPA 1967). It was argued that the broad generic disclosure was sufficient, however the CCPA disagreed stating:

The trouble is that there is no such disclosure, easy though it is to imagine it. It is equally easy to imagine that the compound of claim 13 might have been named in the specification. Working backward from a knowledge of chlorpropamide, that is by hindsight, it is all very clear what route one would travel through the forest of the specification to arrive at it. But looking at the problem, as we must, from the standpoint of one with no foreknowledge of the specific compound, it is our considered opinion that the board was correct in saying:

Not having been specifically named or mentioned in any manner, one is left to selection from the myriads of possibilities encompassed by the broad disclosure, with no guide indicating or directing that this particular selection should be made rather than any of the many others which could also be made. *Id.* at 123.

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In view of the amendment and discussion above, it is respectfully submitted that the present application is in condition for allowance. A reconsideration and notice of allowance are earnestly solicited.

Applicants believe that additional fees are not required for consideration of the within Amendment. However, if for any reason a fee is required, a fee paid is inadequate or credit is owed for any excess fee paid, you are hereby authorized and requested to charge Deposit Account No.: 04-1105.

Respectfully submitted,

Date: 6/6/03

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